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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,976	08/21/2003	Shouhei Kozakai	0171-1012P	6358

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EXAMINER

ROBERTSON, JEFFREY

ART UNIT PAPER NUMBER

1712

DATE MAILED: 04/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/644,976

Applicant(s)

KOZAKAI ET AL.

Examiner

Jeffrey B. Robertson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 0803.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of copending Application No. 10/676,146. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the instant application encompasses the composition in claim 1 of application 10/676,146. Specifically, both claim 1 of the instant application and claim 1 of the '146 application set forth a partially condensed mixture of a diorganopolysiloxane containing hydroxyl groups of formula (1) and an organopolysiloxane copolymer. The language of claim 1 of the instant application allows for the presence of alkenyl groups in the copolymer and a platinum based catalyst. In addition, the silane component (B) encompasses the silane of general formula (2) set forth in the '146 application. Claims 2-5 of each application are identical.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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5. Claims 1, 2, 4, and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoki (US 2002/0013386 A1) in view of Cifuentes et al. (U.S. Patent No. 5,508,360).

For claims 1 and 2, Aoki teaches a silicone composition that contains 100 parts by weight of a condensation product of a diorganopolysiloxane that is hydroxyl terminated and contains not less than 500 repeat units with a organopolysiloxane that contains MQ units in a ration of 0.6 to 1.3, which is within applicants range. Paragraphs [0011]-[0015]. The composition also contains a peroxide-curing agent. Paragraph [0016]. Aoki also teaches that the organopolysiloxane contains hydroxyl groups in paragraph [0022].

For claims 4 and 5, Aoki teaches the formation of films containing the composition of the patent, where the composition is cured. See paragraphs [0028], [0029], and [0047].

Aoki fails to teach the addition of a silane compound corresponding to applicant's component (B).

Cifuentes teaches pressure sensitive adhesive compositions formed from silicone resins and diorganopolysiloxane polymers. See col. 2, lines 25-56. In column 9, lines 27-40, Cifuentes teaches that a silane is added in an amount of 0.01 to 10 percent by weight in order to cap any unreacted hydroxyl groups on the organopolysiloxane resin, to consume excess water, and to act as an adhesion promoter. In column 14, Table 1 and claim 22, Cifuentes prefers the use of glycidoxypropyltrimethoxysilane.

Cifuentes and Aoki are analogous art in that they both come from the same field of endeavor, namely pressure sensitive adhesives containing organopolysiloxane resins and diorganopolysiloxanes. It would have been obvious to one of ordinary skill in the art at the time of the invention to add the silanes of Cifuentes to the compositions to Aoki. The motivation would have been that Cifuentes teaches several advantages for the addition of the silanes as set forth above. One of ordinary skill in the art would have added the silane to impart these advantages to the compositions of Aoki.

### ***Conclusion***


6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Favre et al. (U.S. Patent No. 4,143,088), Schmidt et al. (U.S. Patent No. 5,248,739), Letoffe (U.S. Patent No. 3,983,265), Brady et al. (U.S. Patent No. 5,389,170), Cifuentes et al. (U.S. Patent No. 5,776,614), Lin (U.S. Patent No. 5,580,915), Cifuentes et al. (U.S. Patent No. 5,916,981), Feder et al. (U.S. Patent No. 5,973,061), and Greenberg et al. (U.S. Patent No. 6,387,487) are cited for general interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey B. Robertson whose telephone number is (571) 272-1092. The examiner can normally be reached on Mon-Fri 7:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jeffrey B. Robertson  
Primary Examiner  
Art Unit 1712

JBR